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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : HING et al. Confirmation No: 8656
Appl. No. : 09/787,922
Filed : June 13, 2002
Title : FOAMED CERAMICS

TC/A.U. : 1731
Examiner : C. Fiorilla

Docket No.: HING3001/REF
Customer No: 23364

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT OR IN THE
ALTERNATIVE TO REVIVE AN UNINTENTIONALLY ABANDONED
APPLICATION UNDER 37 C.F.R. § 1.137 (b)**

MS Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This petition is filed in the alternative since it is believed that the Request for Continued Examination (RCE) complied with all of the requirements of 37 CFR § 1.114 including the filing of a proper submission, in this case an Information Disclosure Statement (IDS), and the required fee. Section (d) of the rule states that if applicant timely files a submission and fee set forth in §1.17(e), the office will withdraw the finality of any Office Action and the submission will be entered and considered. Since the requirements of the rule have been met, the Office should proceed in accordance with the rules and not hold the application abandoned as has been done because box c) of the RCE form was not checked to request incorporation by reference the argument in the briefs. The holding of abandonment is believed to be clearly in error and should be withdrawn.

A Request for Continued Examination (RCE) was timely filed in this application on March 8, 2005, after an appeal brief was filed and forwarded to the Board of Patent Appeals and Interferences. The board in a paper dated March 24, 2005 advised the undersigned that the appeal has been considered to be withdrawn. The appeal brief

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and the reply brief were fully responsive to all of the issues raised in the final rejection and the Examiner's Answer and are of record.

However, the undersigned attorney received a notice of abandonment of the application because the submission filed with the RCE was said to have failed to comply with 37 CFR 1.114(c). This section considers an information disclosure statement a proper submission. **An Information Disclosure Statement (IDS) with the required reference was filed along with the required fee for the RCE on March 8, 2005.** It is submitted that this was sufficient to comply with the rules. That is, the RCE was filed, with a proper submission, the IDS, and the required fee. This fully complied with the rules and the application should not be held to be abandoned.

Clearly, the appeal and reply briefs which were already of record and were fully responsive to the final rejection. The object in filing the RCE was to have the additional prior art considered. It is recognized by the undersigned attorney that the RCE transmittal form did not contain a statement that incorporates by reference the arguments in the Briefs filed but these documents are still of record. It is most respectfully submitted that all of the rules had been complied with and the holding of abandonment should be withdrawn. It is not seen how failure to check this box negates the appropriate action taken to file an RCE with an IDS and the required fee. To do so is a clear misinterpretation of the rules.

37 CFR §1.114(d) only states that an appeal brief or reply brief will not be considered a submission under this section. However, the submission of the IDS is clearly a proper submission. Section (d) of the rule states that if applicant timely files a submission and fee set forth in §1.17(e), the office will withdraw the finality of any Office Action and the submission will be entered and considered. Since the rules have been complied with, the holding of abandonment should be withdrawn in the interest of justice and fairness.

Should the request for withdrawal of the holding of abandonment not be granted, the undersigned attorney reserves all rights to further petition but hereby states that the

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entire delay in filing the proper reply from the due date for the required reply until the filing of a grantable petition under 37 CFR §1.137(b) was unintentional.

Submitted herewith is the compliant reply which is an RCE in accordance with the MPEP including the statement that incorporates by reference the arguments filed in the Reply Brief for which the required fee in the amount of \$395 for a small entity has already been paid at the time of filing as noted above. Accordingly, it is most respectfully requested that the holding of abandonment be withdrawn or in the alternate, the application be revived and the prosecution reopened to take into consideration the additional prior art.

The Commissioner is hereby authorized to charge any fees deemed necessary for this petition under 37 CFR 1.137(b) including the fee under 37 CFR §1.17(m) in the amount of \$750, for a small entity to Deposit Account No. 02-0200. A duplicate copy of this paper is also enclosed.

Respectfully submitted,

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Date: April 27, 2005